

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLAF VANCURA

Application No. 09/875,753



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on July 24, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

In response to the Final Rejection, mailed June 24, 2002 (Paper No. 12), Appellant filed a Notice of Appeal, dated August 22, 2002 (Paper No. 13), followed by an Appeal Brief filed on

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February 24, 2003 (Paper No. 15). In response to Appellant's Appeal Brief, an Examiner's Answer was mailed May 16, 2003 (Paper No. 17). The Examiner's Answer contains the following prior art:

Thomas, et al. 6,190,225

Perrie, et al. 6,173,955

Marnell 5,393,057

These references were used for the first time in the Examiner's Answer to show the state of the art, however, these references may constitute the introduction of a new ground of rejection.

See MPEP 1208.01.

The Examiner's Answer cites reference, "Walker" (Patent Number 6,193,606). The Examiner previously cited this reference in the November 6, 2001 Office action, as the basis for a 35 U.S.C. 102(e) rejection; however, the Examiner did not repeat this rejection in the Final Office action, dated June 24, 2002. Therefore, citing this reference in the Examiner's Answer may also constitute the introduction of a new ground of rejection.

Section 1208.01 of the Manual of Patent Examining Procedure (MPEP) (8th ed., Aug. 2001) states:

37 CFR § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of

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the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

Additionally, Appellant's filed an Information Disclosure Statement (IDS) on May 3, 2002 (Paper No. 7). It is not clear from the record that this submission has been considered or whether the Examiner notified appellants of whether their submission did not meet the criteria set forth in 37 CFR §§1.97 and 1.98.

Accordingly, it is

ORDERED that the application is returned to the examiner for resolution of the following issues:

1) Two new possible ground of rejection in Examiner's Answer: Reopen prosecution and/or withdraw the two new ground(s) of rejection and remail the Examiner's Answer; and

2) Information Disclosure Statement (IDS): consideration of the IDS filed May 3, 2002 (Paper No. 7) is necessary.

Notification to appellants in writing of consideration is required; and

3) Any further action as deemed appropriate.

It is important that the Board of Patent Appeals and

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Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES



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